

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Geoffrey B. Rhoads
Title: METHOD FOR INCREASING THE FUNCTIONALITY OF A
MEDIA PLAYER/RECORDER DEVICE OR AN
APPLICATION PROGRAM
Appl. No.: 10/658,808
Filing Date: 9/8/2003
Examiner: Chen, Shin Hon
Art Unit: 2431
Confirmation Number: 1809

**PETITION FOR ACKNOWLEDGMENT OF PRIORITY CLAIM UNDER 37 C.F.R.
§ 1.78 or 37 C.F.R. § 1.182**

Mail Stop Petitions
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 1.78, Applicant hereby petitions for acknowledgment of a properly submitted priority claim for the benefit of a previously-filed U.S. provisional application. Alternatively, Applicant hereby petitions for acknowledgment of a properly submitted priority claim for the benefit of a previously-filed U.S. provisional application under 37 C.F.R. § 1.182.

I. Statement of the Facts

On page 2 of the Final Office Action dated May 3, 2011, the Examiner objected to the claimed priority date of Claims 1-8, 12-21, 23-28, 37, 39, 40, 53, 56, and 58-64 as allegedly not being supported by U.S. Provisional Application 60/134,782. The present application claims the benefit of U.S. Provisional Application 60/134,782. Page 2 of the Final Office Action states:

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. ...

The disclosure of the prior-filed applications, Application No. 09/476,686; 60/134,782; 09/343,104; 09/314,648; 60/134,782; 10/306,768; 09/292,569; 09/186,962; 08/649,419; 60/082,228; 09/186,962; 08/694,419; 08/637,531, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The claims disclose limitation that may be beyond scope of prior art disclosure. Furthermore, the priority information do not support all of the claims (e.g. notification of the winning of a price, displaying indication of a match, etc). ...

In the prior Non-final Office Action dated November 23, 2010, the Examiner made similar arguments. Petitioner respectfully disagrees. The Examiner and Petitioner's representative, Eric Huston, have discussed the priority issue as well as the other issues in this matter on numerous occasions. In particular, Petitioner notes that in the previous two actions, the Office has issued derivation and interference rejections, both of which were improper and subsequently withdrawn.

II. Points to be Reviewed

Petitioner properly claimed the benefit of U.S. Provisional Application 60/134,782—this is not in dispute. As noted above, the Examiner objects to the support in U.S. Provisional Application 60/134,782 for the present claims.

MPEP 201.11.I.A. states in part:

A claim is not required in a provisional application. However, for a claim in a later filed nonprovisional application to be entitled to the benefit of the filing date of the provisional application, the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter of the claim in the later filed nonprovisional application. If a claim in the nonprovisional application is not adequately supported by the written description and drawing(s) (if any) of the provisional application (as in New Railhead), that claim in the nonprovisional application is not entitled to the benefit of the filing date of the provisional application. If the filing date of the earlier provisional application is necessary, for example, in the case of an interference or to overcome a reference, care must be taken to ensure that the disclosure filed as the provisional application adequately provides (1) a written description of the subject matter of the claim(s) at issue in the later filed nonprovisional application, and (2) an enabling disclosure to permit one of ordinary skill in the art to make and use the claimed invention in the later filed nonprovisional application without undue experimentation.

For at least the following reasons, Petitioner submits that Petitioner has complied with the conditions for receiving the benefit of the earlier filing date of U.S. Provisional Application 60/134,782 under 35 U.S.C. §§ 119(e) and 120.

Petitioner submits that support for Claims 1-8, 12-21, 23-28, 37, 39, 40, 53, 56, and 58-64 can be found throughout U.S. Provisional Application 60/134,782, filed May 19, 1999, to which the present application claims benefit. In particular, support for Claims 1-8, 12-21, 23-28, 37, 39, 40, 53, 56, and 58-64 can be found at least in:

- Page 4, line 16 through page 5, line 11.
- Page 6, lines 20-31
- Page 10, lines 25-30
- Page 12, lines 13-18
- Page 14, lines 1-16
- Page 16, line 20 through page 19, line 10.

Petitioner notes that the material from U.S. Provisional Application 60/134,782, filed May 19, 1999, is included **verbatim** in the parent application and the present application.

Specifically, the material from U.S. Provisional Application 60/134,782 can be found at least beginning at column 8, line 50 of U.S. Patent No. 7,562,392, the parent application. In the present application, the material from U.S. Provisional Application 60/134,782 can be found at least beginning at paragraph [0064], with reference to the publication. Thus, Petitioner submits that there is support in the priority applications at least back to May 19, 1999.

In addition, Petitioner notes that priority dates are determined on a claim-by-claim basis. Petitioner notes that the Final Office Action does not specifically identify a claim that lacks support.

For at least these reasons, Petitioner submits that Petitioner has complied with the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §§ 119(c) and 120.

III. Action Requested

Petitioner respectfully requests that the priority claim to U.S. Provisional Application 60/134,782 be acknowledged by the Office, and that pending Claims 1-8, 12-21, 23-28, 37, 39, 40, 53, 56, and 58-64 of the present application be accorded a priority date of at least May 19, 1999, which is the filing date of U.S. Provisional Application 60/134,782.

* * *

This Petition accompanies an Amendment and Reply under 37 C.F.R. § 1.114, a Request for Continued Examination, and a Petition for Suspension of Action.

Petitioner does not believe that a fee is due.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this response, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date November 3, 2011

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